REMARKS

The Office Action dated January 23, 2008, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-34 and 36-47 are currently pending in the application, of which claims 1, 24, and 47 are independent claims. Claims 1-34 and 36-47 are respectfully submitted for consideration.

Claims 14 and 37 were objected to as being dependent upon rejected base claims, but were indicated as containing allowable subject matter. Applicant thanks the Examiner for this indication of allowable subject matter, but Applicant respectfully submits that the claims upon which claims 14 and 37 respectively depend should also be found to contain allowable subject matter, as discussed at greater length below. Thus, it is respectfully requested that the objection to claims 14 and 37 be withdrawn.

Claims 1-4, 6, and 15-23 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Application Publication No. 2003/0093545 of Liu et al. ("Liu"). Applicant respectfully traverses this rejection.

Claim 1, upon which claims 2-23 depend is directed to a method including establishing a mobile packet data connection for a subscriber. The method also includes establishing, over said established mobile packet data connection, a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source. The method further includes terminating the streaming connection between said subscriber and said streaming source. The method

additionally includes measuring a duration of said continuous media stream. The method also includes charging said streaming connection based on said measured duration of said continuous media stream.

Applicant respectfully submits that Liu fails to disclose or suggest all of the elements of any of the presently pending claims.

Liu generally relates to a method and system for downloading data to a portable electronic device. More specifically, Liu discusses an arrangement for downloading data to a portable electronic device, in which the arrangement enables a terminal user to login from anywhere to a service management center through a wired (*e.g.* a computer device) or a wireless (*e.g.* a WAP telephone) network connection. This, in turn, allows the user to manage and browse e-books (and/or *e.g.* pictures, images, sounds, etc.), as well as to download required e-books.

As described at paragraph [0022] of Liu, an e-book file required by a user of a cellular phone 11 is divided into file sections according to transmission bandwidth, and the divided sections are converted into a displayable format of the cellular phone 11. Then, the divisions of the e-book file are transmitted in sequence.

Next, as described at paragraph [0023] of Liu, the cellular phone 11 receives the divisions in stack manner, and places them into a download storing region 110. For reading, a decoding module 111 receives the divisions from the download storing region 110 in sequence and decodes the divided e-book file. Then, the decoded e-book file is displayed by a reading platform 112.

Claim 1 recites, in part, "establishing, over said established mobile packet data connection, a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source." Liu fails to disclose or suggest at least this feature of claim 1.

The Office Action took the position that this feature is disclosed by Liu in Figure 1 and at paragraphs [0015] and [0016]. The cited passages, however, make no mention of establishing "a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," as recited in claim 1.

Indeed, as can be seen from the discussion above, Liu fails to teach or suggest a streaming connection comprising a continuous media stream configured for real-time playback. Rather, Liu merely discloses an e-book file download that is non-streaming and not configured for real-time playback. <u>Since **all the divisions** of the e-book file must be downloaded</u> (and decoded) **before the e-book file can be displayed, the playback of the e-book is non-real-time.** Consequently, the connection on which the e-book file is being downloaded is non-streaming.

The well established meaning of "streaming media" or "media stream" within the art (at the time the invention was made, at the time the application was filed, and at the present time) is that the terms relate to media that is continuously received by and displayed to the end-user <u>while</u> it is being delivered by the provider. An e-book file that is displayed after being delivered is not "streaming media" as understood by a person of

-4-

ordinary skill in the art. For example, techdictionary.com (retrieved on October 29, 2007, from http://techdictionary.com/ using the search term "streaming") defines "streaming" as: "Playing audio or video immediately as it is downloaded from the Internet, rather than storing it in a file on the receiving computer first. Streaming is accomplished by way of web browser plug-ins, which decompress and play the file in real time; a fast computer and fast connection are necessary." That such an interpretation, which is the broadest reasonable interpretation of the term "streaming media" and/or "media stream," is the correct interpretation is reinforced by the term "real-time playback," which makes little sense unless "streaming media" and/or "media stream" is correctly understood.

The Office Action, at page 11, in the "Response to Arguments" section, provided some comments regarding the distinctions identified above. Applicant respectfully submits that the comments are insufficient to support the rejection.

The Office Action argued, in essence, that Liu discloses downloading from a streaming source as well as playback functions. Furthermore, the Office Action argued that the "encoded" and "decoded" steps are the to process data, and are well known steps in the art. The Office Action, however, appears to reflect a misunderstanding regarding the distinction raised, as the Office Action's arguments could be taken as completely true (not admitted), and yet the distinction identified above would still exist.

As noted above, because **the whole file** must be downloaded before it can be viewed in or otherwise played back in Liu, therefore Liu is not discussing or disclosing real-time playback. The fact that Liu's system does not do real-time playback, not that

Liu additionally performs encoding/decoding, is the emphasis of the distinctions noted above. Claim 1, as noted above, recites "a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," which cannot correspond to Liu's disclosure.

The Office Action's apparent argument that Liu discloses downloading a file from a streaming source is not enough to resuscitate the rejection, because Liu clearly requires that the entire file be downloaded before playback can occur, which categorically prohibits Liu's system from performing "real-time playback between said subscriber and a streaming source," as recited in claim 1.

In short, the argument is not that any encoding/decoding steps prevent downloaded data from being non-streaming, but that the file (for example, an e-book file) must in Liu be downloaded completely before it can be viewed. This requirement that that the whole file be downloaded before it is viewed is what causes the download data to be considered non-streaming. That is, if the data were streaming, it could be viewed/played while it is being downloaded. Applicant respectfully submits that the Office Action nowhere points out Liu's system could view/play the data while it is being downloaded, and consequently has essentially conceded the point that Liu contains no such teaching.

Furthermore, as a matter of fact, contrary to the Office Action's assertions, and as explained above, the service management center of Liu is not a streaming source. Liu does not refer to the service management center of Liu as a streaming source, and one of ordinary skill in the art would not consider the service management center of Liu to be a

streaming source. Accordingly, claim 1 is distinguishable over Liu for at least this further reason, with respect to the features, "a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source."

The Office Action, at page 12, in the "Response to Arguments" section, provided some further comments regarding this distinction. Applicant respectfully submits that the further comments are also insufficient to support the rejection.

The Office Action argued in essence that the feature, "establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," recited in claim 1, is simply an intended use. This is incorrect. The feature, "establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," is a step of the method of claim 1. It is the second step of the method.

The Office Action presented no reason to support its assertion that "establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," is merely an intended use, and the feature is not in the preamble of the claim or phrased in terminology that would suggest it is merely an intended use. Thus, the Office Action's position is erroneous.

The Office Action asserted that "If the prior art structure is capable of performing the intended use, then it meets the claim." The system of Liu, however, is not capable of

performing, "establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," for the reasons already discussed above. Thus, even if the remainder of the Office Action's position were correct (not admitted), the rejection still could not stand. Thus, it is respectfully requested that the rejection be withdrawn.

Claim 1 also recites, "establishing a mobile packet data connection for a subscriber." Liu further fails to disclose or suggest at least this feature of claim 1, because Liu merely discloses using a WAP cellular phone.

It should be understood that a WAP cellular phone does not require a packet data connection. Instead, a WAP cellular phone can utilize, for example, Short Message Service (SMS) messages. Dividing the e-book file into sections strongly suggests to an ordinarily skilled artisan that SMS messages (rather than a packet data connection) should be used (since the sections would be able to fit into SMS messages, unlike an entire e-book). See, for example, paragraphs [0004] and [0022] of Liu. Thus, there is not only no explicit disclosure or suggestion of establishing a packet data connection, the teaching of division into sections teaches away from establishing a packet data connection in favor, instead, of using SMS messages.

At pages 12-13, the Office Action provided some comments regarding this distinction. Applicant respectfully submits that the comments are insufficient to support the rejection.

The Office Action argued, in essence, that Liu discloses a cellular telephone connecting to a service management center via a network communication system 2. The network communication system 2 includes a network system that includes the Internet, apparently for the provision of a data service. The Office Action asserted that "it is inherent that the connection is for mobile packet data." Applicant respectfully disagrees with the Office Action's assertions and conclusions.

The fact that a cellular phone can establish a connection to the Internet does not imply in any way that mobile portion of the connection is necessarily packet-switched. The conventional art at the time of Liu included, for example, established techniques, such as circuit-switched (*i.e.* non-packet data connections) cellular data connection techniques: for example, Circuit-Switched Data (CSD) and High-Speed Circuit-Switched Data (HSCSD), as well as the use of modems. CSD is the original form of data transmission developed for Time Division Multiple Access (TDMA)-based mobile phone systems, such as Global System for Mobile Communications (GSM). HSCSD is a later enhancement to CSD. These techniques were in use during the approximate time period of the late 1990's to 2003. Considering the filing date of Liu, one of ordinary skill in the art would have understood that such non-packet data connections were intended by the disclosure of Liu.

Accordingly, it is respectfully requested that, for each of the reasons set forth above, the rejection of claim 1 be withdrawn.

Claims 2-4, 6, and 15-23 depend from and further limit claim 1. Each of claims 2-4, 6, and 15-23, therefore, recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that the rejection of claims 2-4, 6, and 15-23 be withdrawn.

Claims 7-8 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of U.S. Patent Application Publication No. 2006/0048669 of Kinno et al. ("Kinno"). The Office Action took the position that Liu discloses many of the features of claims, but cited Kinno to remedy certain deficiencies of Liu with respect to the additional limitations of claims 7-8 and 10. Applicant respectfully traverses this rejection.

Claims 7-8 and 10 depend from and further limit claim 1. At least some of the deficiencies of Liu with respect to claim 1 are discussed above. Kinno cannot remedy the above-identified deficiencies of Liu, and consequently the combined disclosures of Liu and Kinno cannot provide all of the elements of any of any of the presently pending claims.

Kinno generally relates to an information delivery system, an information delivery method, an information delivery server, and a content delivery server and client terminal. More specifically, Kinno discusses a multimedia content delivery arrangement wherein multimedia content is delivered by streaming from a content delivery server to a client terminal. Kinno was only cited for the purpose of features in the dependent claims

related to time stamps. Accordingly, it is unsurprising that Kinno fails to remedy Liu's deficiencies with respect to independent claim 1

Furthermore, it would not have been obvious to include either a real-time playback feature or a streaming connection in Liu, because of the media that Liu is seeking to provide. Liu is seeking to provide e-books, but one of ordinary skill in the art would have seen no reason to provide e-books on a "real-time" basis, as one of ordinary skill in the art would have tended to view e-books as having essentially static and non-time-sensitive content. Accordingly, even if other art existed (not admitted) that would teach the features of claim 1 that Liu does not, one of ordinary skill in the art would not have found motivation to use such features in combination with the features of Liu, because there would not have been any expected anticipation that the results of adding the complexity of real-time stream capabilities would have been beneficial to readers of e-books, the main thrust of Liu's concern.

Thus, it is respectfully submitted that the combination of Liu and Kinno fails to disclose or suggest all of the elements of any of claims 7-8 and 10, and it is respectfully requested that the rejection of claims 7-8 and 10 be withdrawn.

The Office Action, at page 14 in the "Response to Arguments" section, provided some comments regarding the failure of Kinno to remedy the deficiencies of Liu. The comments, however, are inadequate to support the rejection.

The Office Action first argued that recognition of a previously unappreciated advantage that flows from the prior art is not the basis for patentability. This argument is

not germane to the issues raised above. The issues raised above relate to the deficiencies of the combination of references to disclose what is claimed. Because Kinno was cited for only features related to time stamps, it is no surprise that it fails to supplement Liu with respect to features such as, "establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," as recited in claim 1.

The Office Action next argued that Applicant's argument incorrectly addressed the cited art. The Office action stated, "one cannot show nonobviousness by attacking the references individually where the rejections are based on combinations of references," and cited *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant respectfully submits that the Office Action's reliance on *Keller* and *Merck* is misplaced. Applicant's response follows the pattern laid out by the Federal Circuit: identify the deficiencies of the primary reference, and determine whether the secondary reference remedies those deficiencies. *In re Rijckaert*, 28 USPQ2d 1955, 1956-7 (Fed. Cir. 1993). Additionally, as the Federal Circuit has explained, Applicant is not required to show nonobviousness until a *prima facie* case for obviousness has been established. *Rijckaert* at 1957. Additionally, Applicant has not addressed a reference in isolation, like the applicant in *Merck*, nor has Applicant provided an affidavit regarding a solitary reference like the applicant in *Keller*. Accordingly, Applicant's argument complies with the law as set forth by the Federal Circuit.

Additionally, in view of Kinno's filing date of August 25, 2005, Applicant respectfully asserts that Kinno *as U.S. Patent Application Publication No. 2006/0048669, published March 9, 2006,* is not proper prior art under 35 U.S.C. 102(e) (or any other section) because it was both filed and published after the filing date of the present application. Applicant notes for the Examiner's convenience that Kinno is related to U.S. Patent Application No. 10/359,662, which apparently was filed on February 7, 2003, shortly before the filing and current priority date of the present application. For this additional reason, it is respectfully requested that the rejection be withdrawn.

At pages 14-15, the Office Action responded to the issue of Kinno's "prior art" status. The Office Action's response, however, in regard to the matter of Kinno not being proper prior art is clearly erroneous.

The Office Action argued that Kinno is being cited under 35 U.S.C. 103, not 35 U.S.C. 102(e). The only way, however, that a reference is a valid reference under 35 U.S.C. 103, is if it is a citable reference under one or more subsection of 35 U.S.C. 102. 35 U.S.C. 103(a) relaxes the content requirements, it does not relax the date requirements, and does not provide for later-filed references to be considered prior art. Since, as the Office Action appears to have conceded, Kinno is not citable (based on its filing and/or publication dates) under any subsection of 35 U.S.C. 102, it is also not citable under 35 U.S.C. 103.

The Office Action makes reference to U.S. Patent Application Serial Number 10/359,662 (the '662 application), which was filed (according to the Office Action) on

February 7, 2003. No publication of the '662 application or patent issued on the '662 application, however, has been cited in the rejection. 35 U.S.C. 102(e) provides no provision for the consideration of priority dates beyond the international filing dates of certain PCT applications filed under 35 U.S.C. 371, which is not germane to Kinno. Thus, even if Kinno were to properly claim the priority of the '662 application (not admitted), that would not make the filing date of Kinno under 35 U.S.C. 102(e) any earlier. Thus, the rejection is improper and should be withdrawn.

Claims 11-13, 24-34, 36, and 38-47 were rejected under 35 U.S.C. 103(a) as being patentable over Liu in view of U.S. Patent Application Publication No. 2003/0078031 of Masuda ("Masuda"). Applicant notes that there was some inconsistency with respect to the rejections of claims 24-33 and 38-47: they are listed as rejected the combination of Liu and Masuda, but the detailed explanation directs the reader to the rejections of claims 1-4, 6-8, and 15-23, none of which were rejected under such a combination of references. Clarification of the rejection is requested, if the rejection is – for any reason – to be maintained. The Office Action asserted that Liu discloses many features of the claims, but cited Masuda to remedy various deficiencies of Liu. Applicant respectfully traverses this rejection.

At least some of the deficiencies of Liu with respect to claim 1 are discussed above. Independent claims 24 and 47 each have their own scope (which is highlighted by the fact that they have been rejected separately from claim 1), but each recite at least some features similar to those discussed above, with respect to claim 1 and for which Liu

is deficient. Likewise, claims 11-13, 25-34, 36, and 38-46 depend from, and further limit, claims 1 and 24. Masuda fails to remedy the above-identified deficiencies of Liu, and consequently the combination of Liu and Masuda fails to disclose or suggest all of the elements of any of the presently pending claims.

Masuda generally relates to a communication system. More specifically, Masuda discusses a communication system capable of conducting multiple pre-paid mobile telephone services at the same time for one user. Both because of this general nature of the disclosure, and because Masuda was only cited with respect to media stream control issues, it is unsurprising that Masuda fails to remedy the deficiencies of Liu, which are discussed at length above.

Furthermore, as discussed above with respect to the alleged combination of Liu and Masuda, the same combinatorial issues exist with respect to any alleged combination of Liu and Masuda that would include real-time playback functionality or media stream/streaming media features. Briefly, because Liu relates to e-books, there would be no reason or incentive to make Liu include any real-time playback (since e-books are not conventionally presented in real-time formats) or in streaming media (since e-books are not ordinarily particularly time sensitive). Thus, it is respectfully submitted that Masuda cannot remedy the deficiencies of Liu, and it is respectfully requested that the rejection of claims 11-13, 24-34, 36, and 38-47 be withdrawn.

The Office Action, in the "Response to Arguments" section, at page 16, presented some comments regarding the above-identified deficiencies of the rejection. These

comments were essentially the same comments as presented with respect to the rejection of Liu and Kinno (except for the issues of whether Kinno is prior art). The comments here are likewise unable to resuscitate the rejection, for the same reasons as already stated above with respect to the rejection based on the combination of Liu and Kinno. Neither is this a situation in which arguments are being attacked individually, nor is this a situation in which patentability is being alleged based on an appreciation of naturally flowing advantages of the prior art. Timely withdrawal of the rejection is respectfully requested.

Claims 5 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of U.S. Patent Application Publication No. 2003/0216145 of Cox et al. ("Cox"). The Office Action took the position that Liu discloses most of the features of the claims, but cited Cox to remedy certain deficiencies of Liu with respect to the further limitations of the claims. Applicant respectfully traverses this rejection.

Claims 5 and 9 depend from and further limit claim 1. At least some of the deficiencies of Liu with respect to claim 1 are discussed above. Cox does not remedy the above-identified deficiencies of Liu, and consequently the combination of Cox and Liu fails to disclose or suggest all of the elements of any of the presently pending claims.

Cox generally relates to a method of providing directional assistance to a telephone subscriber. More specifically, Cox generally aims to improve directory assistance by overcoming problems associated with directory assistance services. Cox

was cited only with respect to the further limitations of claims 5 and 9. Accordingly, it is unsurprising that Cox fails to remedy the above-identified deficiencies of Liu.

Because Cox fails to remedy the above-identified deficiencies of Liu, the combination of Liu and Cox fails to disclose or suggest all of the elements of claims 5 and 9, and it is respectfully requested that the rejections of claims 5 and 9 be withdrawn.
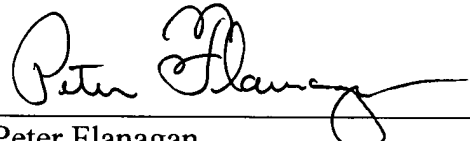
The Office Action, in the "Response to Arguments" section, at page 17, presented some comments regarding the above-identified deficiencies of the rejection. These comments were essentially the same comments as presented with respect to the rejection of Liu and Kinno (except for the issues of whether Kinno is prior art), and the same comments as presented with respect to the rejection based on Liu and Masuda. The comments here are likewise unable to resuscitate the rejection, for the same reasons as already stated above with respect to the rejection based on the combination of Liu and Kinno and the combination of Liu and Masuda. As in those rebuttals to the Office Action's rejections, neither is this a situation in which arguments are being attacked individually, nor is this a situation in which patentability is being alleged based on an appreciation of naturally flowing advantages of the prior art. Timely withdrawal of the rejection is respectfully requested.

For the reasons set forth above, it is respectfully submitted that each of claims 1-34 and 36-47 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-34 and 36-47 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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